

REMARKS

After entry of the instant Amendment, claims 1, 3-9, 12, 15, 16, 19, 21, and 22 remain in the application with claim 1 in independent form. Independent claim 1 has been amended to specify that the silicone based adhesive agent layer is formed directly on the undercoat layer, which clarifies the scope of the invention claimed in independent claim 1. Claims 21 and 22 are new. Claims 2, 10, 11, 13, 14, 17, 18, and 20 were previously cancelled. Claims 6-9 were previously withdrawn from consideration subject to possible rejoinder should independent claim 1 be allowed. No new subject matter has been added through the amendments to the instant claims.

Support for the amendment to independent claim 1 can at least be found in paragraph [0031] of the application as filed, wherein reference is made to the fact that the undercoat layer is placed in contact with the silicone based adhesive agent layer, and wherein further reference is made to peeling properties of the undercoat layer with respect to the silicone based adhesive agent layer. The Figures also show the undercoat layer and the silicone based adhesive agent layer to be in direct contact. Support for new claims 21 and 22 can at least be found in paragraphs [0055] and [0056], which describe the separation of the semiconductor wafer (or chip) and silicone based adhesive agent layer from the undercoat layer and further describe the semiconductor wafer (or chip) having the silicone based adhesive agent layer bonded thereto. The Figures also support new claims 21 and 22 by illustrating that the silicone based adhesive agent layer is the only layer that is disposed between the undercoat layer and the wafer, and by further illustrating that the silicone based adhesive agent layer is the only layer that is bonded to the semiconductor wafer after the

silicone based adhesive agent layer is stripped from the undercoat layer (see Figure 7, in particular).

Claims 1, 3-5, 12, 15, 16, and 19 stand rejected under 35 U.S.C. §102(b) over European Patent App. No. 0 571 649 (hereinafter the EP '649 application). In view of the amendment of independent claim 1 to specify that the silicone based adhesive agent layer is formed directly on the surface of the undercoat layer, the Applicants respectfully submit that the instant rejections have been overcome for reasons as set forth below.

In response to the Applicants' Amendment filed on August 18, 2008, the Examiner has maintained the rejections over the EP '649 application on the basis that the EP '649 application teaches a first and second silicone layer bonded to cut chips, with the first and second silicone layers stripped from an undercoat layer. Prior to the instant amendments, independent claim 1 specified that a silicone based adhesive agent layer is formed on an undercoat layer and is stripped from the undercoat layer after bonding to the semiconductor wafer. However, because independent claim 1 did not include a closed transition, the Examiner has interpreted independent claim 1 as not excluding the presence of an additional silicone layer that is also present with the silicone based adhesive agent layer as claimed. The Examiner's arguments appear to be based on the fact that, in the context of the claims prior to implementation of the instant amendments, an additional silicone layer could be disposed between the silicone based adhesive agent layer as claimed and the undercoat layer. Because independent claim 1, prior to amendment, already specified that the claimed silicone based adhesive agent layer includes an adhesive surface adhesively bonded to the semiconductor wafer, it is clear that no additional layer could be present between the

silicone based adhesive agent layer and the wafer in the context of independent claim 1. Thus, in accordance with the Examiner's reasoning, because independent claim 1 prior to entry of the instant amendment did not exclude the presence of another silicone layer between the undercoat layer and the silicone based adhesive agent layer as claimed, such other layers could be present and could also be stripped from the undercoat layer in accordance with independent claim 1.

After entry of the instant amendments to independent claim 1, the Applicants respectfully submit that independent claim 1 can no longer be interpreted in any way to read on the disclosure of the EP '649 application, even though independent claim 1 still does not contain any closed transitions. In particular, independent claim 1 has been amended to specify that the silicone based adhesive agent layer is formed directly on the surface of the undercoat layer. Coupled with the existing features of independent claim 1 that already specified that the claimed silicone based adhesive agent layer includes an adhesive surface adhesively bonded to the semiconductor wafer, it is clear that independent claim 1 does not allow for an interpretation that reads on the disclosure of the EP '649 application. To explain, the silicone based adhesive agent layer that is claimed in independent claim 1 is now specified to be formed directly on the surface of the undercoat layer (thereby foreclosing the possibility of other silicone layers being disposed between the claimed silicone based adhesive agent layer and the undercoat layer), the silicone based adhesive agent layer is stripped from the undercoat layer after bonding to the semiconductor wafer, and the silicone based adhesive agent layer has an adhesive surface that is adhesively bonded to the semiconductor wafer.

The Examiner has already recognized that the EP '649 application requires two distinct silicone layers to accomplish the separate goals of facilitating peeling from an undercoat layer and adequately bonding to a semiconductor wafer. In view of the requirements of the EP '649 application of separate silicone layers to facilitating bonding to the semiconductor wafer and peeling from the undercoat layer, the Applicants respectfully submit that independent claim 1 is novel over the EP '649 application by specifying the claimed silicone based adhesive agent layer as accomplishing both such goals.

Furthermore, there is no basis for the Examiner to conclude that independent claim 1, as amended, is obvious over the teachings of the EP '649 application due to the fact that the invention of EP '649 would be inoperable absent the presence of both adhesive layers taught therein. The instant application also includes Examples that illustrate successful operation of the invention claimed in independent claim 1 with the claimed silicone based adhesive agent layer formed directly on the undercoat layer and with an adhesive surface of the silicone based adhesive agent layer bonded to the semiconductor wafer, wherein no such success can be expected based upon the teachings of the EP '649 application. As such, the Applicants respectfully submit that independent claim 1 is both novel and non-obvious and, thus, is in condition for allowance. The remaining claims each depend upon the novel and non-obvious features of independent claim 1 such that the Applicants respectfully submit that these claims are also in condition for allowance. Finally, the Applicants respectfully request rejoinder of withdrawn claims 6-9 upon allowance of independent claim 1, from which claims 6-9 depend.

This Amendment is timely filed such that it is believed that no fees are presently due. However, the Commissioner is authorized to charge our deposit account no. 08-2789 for any additional fees or credit the account for any overpayment.

Respectfully submitted,

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Date: January 15, 2009

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